

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN V. DECKERS

Appeal No. 2005-2731
Application No. 10/656,040

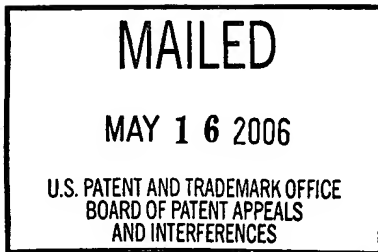
ON BRIEF

Before FRANKFORT, OWENS and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 28, 37, 38 and 44 through 46. Claims 47 through 59, the only other claims remaining in the application, have been withdrawn from further consideration. Claims 1 through 27, 29 through 36 and 39 through 43 have been canceled.

Appellant's invention relates to a data storage apparatus used to access data stored in first and second different types of storage media, i.e., a hard disk drive cartridge and a tape cartridge, wherein the hard disk drive cartridge has a "tape



cartridge form factor" (i.e., a given set of standardized physical configurational and dimensional criteria which apply to the design of cartridges), for example, Digital Audio Tape (DAT), Digital Data storage (DDS), Digital linear tape (DLT). The data storage apparatus includes a picker configured to move both of the different forms of storage media and a docking device in communication linkage with a host device and adapted to receive the first storage media and the second storage media from the picker. Independent claim 28 is representative of the subject matter on appeal and a copy of that claim can be found in the Claims Appendix attached to appellant's brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Stefansky	5,329,412	Jul. 12, 1994
Kim	5,666,342	Sep. 9, 1997
Kulakowski et al. (Kulakowski)	6,731,455	May 4, 2004 (filed Apr. 26, 2001)

Claim 45 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In the examiner's view, this claim contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 28, 37, 38 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kulakowski in view of Stefansky.

Claims 45 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kulakowski in view of Stefansky as applied to claim 28 above, and further in view of Kim.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the answer (mailed May 4, 2005) for the examiner's reasoning in support of the rejections, and to appellant's brief (filed April 25, 2005) and reply brief (filed June 10, 2005) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the examiner's rejection of claim 45 under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling disclosure. It is by now well-established law that the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See, In re Moore, 439 F.2d 1232; 169 USPQ 236 (CCPA 1971). Note also, In re Scarborough, 500 F.2d 560, 182 USPQ 298 (CCPA 1974) and In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Moreover, in rejecting a claim for lack of enablement, it is also well settled that the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement in order to substantiate the rejection. See In re Strahilevitz, 668 F.2d 1229, 212 USPQ 561 (CCPA 1982); In re Marzocchi, 439 F.2d 220,

169 USPQ 367 (CCPA 1971). Once this is done, the burden shifts to appellant to rebut this conclusion by presenting evidence to prove that the disclosure in the specification is enabling. See In re Doyle, 482 F.2d 1385, 179 USPQ 227 (CCPA 1973); In re Eynde, 480 F.2d 1364, 178 USPQ 640 (CCPA 1973).

In the case before us, after reviewing appellant's arguments in the brief and reply brief, the disclosure as set forth in the specification and appellant's claim 45, we are of the opinion that the examiner has not met his burden of advancing acceptable reasoning inconsistent with enablement. The examiner's position as set forth in the answer (page 6) is that

[t]he original disclosure did not provide any enabling evidence for the combination of the docking device being able to actually read/link both the tape and the hard disk to the host. There is no structure description to allow one of ordinary skill in the art to ascertain the physical make up of the integrated docking device. Without such description, one would not be able to make and use the invention without excessive undue experimentation.

Although it is true that appellant has not provided details as to exactly what the structure of a docking device having the capability of receiving and communicating with both a hard disk cartridge and a tape cartridge would look like, we agree with appellant that one of ordinary skill in the art presented with

appellant's disclosure, particularly the portions highlighted at pages 6 and 7 of the brief, would have been able to make and use the docking device schematically shown in Figure 4 of the application drawings and the overall data storage apparatus of claim 45 without the need for undue experimentation. In that regard, we note that the examiner has provided no convincing explanation or line of reasoning as to why making and using a docking device like that set forth in claim 45 on appeal would have required undue experimentation. See, for example, MPEP § 2164.01 and 2164.01(a) for the factors to be addressed by the examiner in establishing that there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement.

As for the examiner's comments bridging pages 6 and 7 of the answer, we agree with appellant's responsive arguments found on pages 2 and 3 of the reply brief, which the examiner has chosen not to rebut. Moreover, in understanding the level of skill in the art, we also note the patent to Ho-Geol Kim (U.S. 5,666,342) applied by the examiner in the rejection of claims 45 and 46 under 35 U.S.C. § 103, which patent discloses a docking device or united tape and disc recording/reproducing device having a united inserting part,

wherein the device is adapted to receive and communicatively interact with both a tape cassette and an optical hard disc.

For the above reasons, we will not sustain the examiner's rejection of claim 45 under 35 U.S.C. 112, first paragraph, as being based on a non-enabling disclosure.

We next consider the examiner's rejection of claims 28, 37, 38 and 44 under 35 U.S.C. § 103(a) as being unpatentable over Kulakowski in view of Stefansky. In maintaining this rejection the examiner urges that Kulakowski discloses a data storage library like that claimed by appellant which is capable of handling tape cartridges or a combination of tape and hard disk drive devices, but "is silent as to the specific of the HDD having form factor in the shape of a tape cartridge" (answer, pages 3-4). To address the noted difference the examiner turns to Stefansky, urging that it discloses a portable hard disk drive (HDD) cartridge that can have the dimension of a tape cartridge (col. 1, lines 21-47). From the disclosures pointed to in the applied patents, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to have the housing dimensions of Kulakowski's HDD coincide with the housing dimensions

of a magnetic tape cartridge, as taught by Stefansky, "since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art" (answer, page 4).

In addition, the examiner urges that it would have been obvious for one of ordinary skill in the art to have provided Kulakowski's HDD with a housing having the same dimension as a magnetic tape housing "because such HDD cover had been known in the art, as demonstrated by Stefansky '412". The examiner further contends that

[s]ince Stefansky '412 modified apparatus and docking device is designed to handle storage media having tape cartridge form factor, it is obvious that the apparatus and the docking device is also capable of handling any tape cartridges" (answer, page 4).

After a review of the applied patents, even if we were to agree that Stefansky teaches a hard disk drive cartridge having a tape cartridge form factor (see, e.g., col. 3, lines 1-3), we agree with appellant that there is nothing in either Kulakowski or Stefansky which would have led one of ordinary skill in the art to modify the dual-ended hard disk drive cartridge (2) of Kulakowski to necessarily have a tape cartridge form factor, since Stefansky gives no reason for having a hard disk drive cartridge configured to have a tape cartridge form factor. Moreover, even if such a

modification were to be made in Kulakowski, we agree with appellant's further assessment that there is no teaching or disclosure in Kulakowski or Stefansky of a data storage library that includes both forms of storage media required in claim 28 on appeal, or of a docking device in communicative linkage with a host device that is capable of receiving and interacting with both forms of data storage media set forth in claim 28. The examiner's finding that Kulakowski (col. 11, lines 21-47) discloses those aspects of the claimed invention is not well founded. In our view, the somewhat expansive and cryptic commentary at column 11, lines 21-47, of Kulakowski fails to reasonably teach or suggest use of two different forms of data storage media in a single automated library system and provides no teaching or disclosure regarding a docking device like that specifically required in claim 28 on appeal. Nor does anything in Stefansky make up for those deficiencies in the disclosure of Kulakowski.

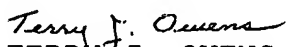
Thus, for the reasons set forth above, we will not sustain the examiner's rejection of claim 28, or of claims 37, 38 and 44 which depend therefrom, under 35 U.S.C. § 103(a).

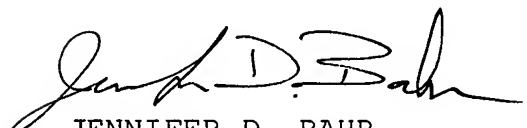
Regarding the rejection of claims 45 and 46 under 35 U.S.C. § 103(a) as being unpatentable over Kulakowski in view of Stefansky and Kim, we have additionally reviewed the Kim patent, but find nothing therein which addresses the deficiencies in the basic combination of Kulakowski and Stefansky noted above. For that reason, the examiner's rejection of dependent claims 45 and 46 under 35 U.S.C. § 103(a) will likewise not be sustained.

In summary: since neither the rejection of claim 45 under 35 U.S.C. § 112, first paragraph, nor either of the obviousness rejections under 35 U.S.C. § 103(a) has been sustained, it follows that the decision of the examiner is reversed.

REVERSED


CHARLES E. FRANKFORT
Administrative Patent Judge


TERRY J. OWENS
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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